



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/173,134	10/15/1998	GEORGE S. GABRIEL	364106/176	1325

7590 11/04/2003
STROOCK & STROOCK & LAVAN
180 MAIDEN LANE
NEW YORK, NY 10038

EXAMINER

NGUYEN, SON T

ART UNIT	PAPER NUMBER
----------	--------------

3643

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/173,134

Applicant(s)

GABRIEL ET AL.

Examiner

Son T. Nguyen

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1,2** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheaffer et al. (US 4,989,545 on form PTO-1449) in view of applicants' admitted prior art (herein AAPA).

For claim 1, Sheaffer et al. disclose a multipurpose cage level barrier rodent cage for housing multiple species of rodents, including mice or rats in a ventilated rack and cage system (as mentioned in applicants' specification on page 1) comprising a cage bottom 22 having a plurality of integral side walls 50, a floor 22 and an open top end closed off by a filter bonnet 24. In addition, Sheaffer et al.'s rack for supporting the cages comprises a ventilating system for directly providing air ventilation to and continuously removing exhaust air from the cages supported by the rack (col. 4, lines 25-39 and col. 5, lines 12-56). Sheaffer et al. are silent about the floor having a length l and a width w wherein $80 \text{ in}^2 \leq l \times w \leq 110 \text{ in}^2$. AAPA submits on page 1 of the specification that one of ordinary skill in the art would recognize the floor area of a cage for laboratory animals to be a parameter that may be varied depending on, among other things, the type and number of animals intended to be housed in order to provide the animals with a hygienic and humane environment. Therefore, it would have been

Art Unit: 3643

obvious to one having ordinary skill in the art at the time the invention was made to have the floor of the cage of Sheaffer with the dimension range as listed above, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 2, again, on page 1 of the specification, AAPA submits that "ILAR guidelines set non-binding minimums for size and dimension of cages for rodents. For mice weighing more than 25 grams, a cage having a floor dimension of at least 15 square inches per mouse is required. Rats up to 400 grams in size require a cage having floor dimensions of at least 40 square inches per rat. Similar requirements are mandated for hamsters and guinea pigs by the AWA". Base on this evidence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a set of dimensions for the floor area of Sheaffer's cage that would result in a floor area of 80 square inches in order to provide a cage having a floor area sufficient to accommodate two rats weighing up to 400 grams each to meet ILAR guidelines and the AWA as discussed by AAPA.

3. **Claims 3,8,9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheaffer et al. (US 4,989,545 on form PTO-1449) in view of Coiro et al. (US 5,894,816 on form PTO-1449).

For claim 3, in addition to the above, fig. 4 and col. 8, lines 57-64 of Sheaffer et al. disclose a double sided rack having a depth. However, Sheaffer are silent about the length of the cage being less than substantially 18 inches. Coiro et al. disclose a cage

Art Unit: 3643

level barrier cage comprising a cage bottom having an inner length 17 at the receptacle rim of about 11.4 inches (col. 5, lines 57-59) and an outer length L6 at rim of the receptacle of 11.75 inches (col. 4, lines 57-58). Based on this, the length of Coiro et al.'s cage is consider to be less than substantially 18 inches. It follows that the length / of Coiro et al.'s cage is also "less than substantially 36 inches" as claimed by applicant in claim 6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a cage level barrier cage as taught by Coiro et al. in Sheaffer's double sided ventilated rack in order to provide a ventilated cage and rack system comprising cages having a usable floor space of 75 square inches, as taught by Coiro in col. 5, lines 60-63, to thereby accommodate up to five mice weighing 25 grams each, while retaining compatibility with existing wire bar lids and microbarrier tops as taught by Coiro in col. 3, lines 17-19.

For claim 8, please see the above paragraphs.

For claim 9, Sheaffer et al. as modified by Coiro et al. disclose the above features except a portion of the cage, when resting within the rack, extends beyond the rack. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a portion of the cage of Sheaffer et al. as modified by Coiro et al., when resting within the rack, extends beyond the rack depending on a chosen length one wishes to have (as long as it meets ILAR guidelines) because one of ordinary skill in the art would recognize the floor area of a cage for laboratory animals to be a parameter that may be varied depending on, among other things, the type and

number of animals intended to be housed in order to provide the animals with a hygienic and humane environment.

Response to Arguments

4. Applicant's arguments filed 8/20/02 have been fully considered but they are not persuasive.

Regarding the Declarations of Nick Guise, Neil Campbell, Dietrich Crase, and Betty Fatzie, these Declarations have been acknowledged and considered by the examiner. However, the examiner believes that the Declarations do not provide sufficient evidence as required for Commercial Success and Long-felt need (MPEP Section 716.03 (a)-(b)), thus they are not persuasive. For example, from the Declaration of Betty Fatzie, the dollar values given by Betty Fatzie (paragraph 12 in the Declaration of Betty Fatzie) are not evidence for commercial success because these values could reflect heavy promotion or advertising, shift in advertising, consumption by purchasers (such as Dietrich Crase who has been purchasing lab cages from LPI at least before 1999, see Declaration of Dietrich Crase, paragraph 4) normally tied to assignee or applicant, or other business events. The inventor's or assignee's opinion as to the purchaser's reason for buying the product (such as the One Cage System being cheaper, thus saving money for purchasers) is insufficient to demonstrate a nexus between the sales and the claimed invention. Conclusory statements or opinions, such as stated in paragraph 10 of the Declaration of Betty Fatzie, of increased sales were due to the merits of the claimed invention are entitled to little weight. Paragraphs 13 & 14 of the Declaration appear to be an opinion of what Betty Fatzie believes how the One

Art Unit: 3643

Cage System has satisfied her customers and not evidence of commercial success.

Paragraph 15 merely states a purchaser's satisfaction with the One Cage System, of which said purchaser (Advance Medicine) normally tied to assignee or applicant since 1999.

Another example, from the Declaration of Dietrich Crase, paragraphs 4,6,11 of the Declaration states that by using the One Cage System, inventories are reduce because Mr. Crase no longer have multiple cages for different animals. However, this statement is not evidence under Long-felt Need because although the claimed invention achieved the desirable result of reducing inventories, there is no evidence of any prior unsuccessful attempts to do so. In addition, no evidence has been provided that shows the long-felt need must not have been satisfied by another before the invention by applicant. Furthermore, paragraph 10 of the Declaration states that the One Cage System is cost savings for the purchasers, which said cost saving is not an evidence for long-felt need because it is not a problem that is existed in the art for a long period of time without a solution. All other declarations are similar to that of the two discussed above.

Applicants state that applicants discovered source of a problem and the solution thereto, therefore, this should overcomes obviousness rejections.

However, applicants failed to show evidence that the problem has been recognized and existed in the art for a long period of time without a solution, and that the need must have been a persistent one that was recognized by those of ordinary skill in the art.

Applicants are not inventing a one-size cage (for example, $l \times w = 80$ square inches) ize

Art Unit: 3643

which fits all rodent species. Instead, applicants are claiming various dimensions depending on the size of the rodent, "80 square inches $\leq l \times w \leq$ 110 square inches" which doesn't all cage makers have to do in order to follow Federal guidelines and regulations? It would be obvious to one of ordinary skill in the art to vary his/her cage dimensions based on the size and type of rodent being contained therein and based on Federal guideline and regulation.

Applicants argued that the references employed in the rejection above lack of motivation to combine. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation or suggestion to combine is to provide a ventilated cage and rack system comprising cages having a usable floor space of 75 square inches, as taught by Coiro in col. 5, lines 60-63, to thereby accommodate up to five mice weighing 25 grams each, while retaining compatibility with existing wire bar lids and microbarrier tops as taught by Coiro in col. 3, lines 17-19. The two references are similar in that they both teach a cage of various dimensions for use with various floor space for various rodent species. Also see comments in the Final Rejection, mailed on 9/26/02, paper # 20.

Art Unit: 3643

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-0765. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 872-9325. The official fax number is 703-872-9306.



Son T. Nguyen
Primary Examiner, GAU 3643
October 31, 2003